

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:	Arnold and Torres	Patent Application
Serial:	09/863,232	Group Art Unit: 2143
Filed:	November 27, 2000	Examiner: Kyung H. Shin
For:	METHOD AND SYSTEM FOR USING TOKENS TO CONDUCT FILE SHARING TRANSACTIONS BETWEEN HANDHELDS AND A WEB SERVICE	

Reply Brief

Table of Contents

	<u>Page</u>
Real Party in Interest	1
Related Appeals and Interferences	2
Status of Claims	3
Status of Amendments	4
Summary of Claimed Subject Matter	5
Grounds of Rejection to be Reviewed on Appeal	11
Arguments	12
Comments in Reply to Examiner's Answer	39
Conclusions	48
Claims Appendix	36
Evidence Appendix	56
Related Proceedings Appendix	57

Real Party in Interest

The assignee of the present invention is Palm, Incorporated.

Related Appeals and Interferences

There are no related appeals or interferences known to the Appellant.

Status of Claims

Claims 1-24 are rejected under 35 U.S.C. § 103(a).

The rejections of Claims 1-24 are appealed.

Status of Amendments

All proposed amendments have been entered. An amendment subsequent to the final rejection has not been filed.

Summary of Claimed Subject Matter

Generally, embodiments in accordance with the present invention allow for a networked mobile computing device to share a file with another mobile computing device, irrespective of its current proximity or availability to the mobile computing device initiating the sharing (“the sending mobile computing device”). Sharing may occur by the sharing mobile computing device passing a token to a web server. The token contains information regarding the name of the file to be shared along with the identify of the receiving mobile computing device. The token is a compact record which can be transferred over wireless networks in a much more efficient manner than sending the entire file. A variation of this embodiment enables a networked mobile computing device to share a file directly, by uploading the file from the mobile computing device along with the token. The token is then used to update the account information of the receiving mobile computing device in order to cause a download to occur between the server and the receiving mobile computing device when the receiver next synchronizes with the server.

Claim 1 recites a method of transferring information. The method is generally described at least in Figures 8 and 9 and in the Specification beginning at page 28 line 1 *et seq.*, *inter alia*.

The method includes: a) at a remote server (Figure 6A, page 22 line 1 *et seq., inter alia.*), responsive to receiving a signal (Figure 4, page 20 line 1 *et seq., inter alia.*) from a first mobile computing device (Figures 2A and 2B, page 13 line 19 *et seq., inter alia.*), accessing an account stored on the remote server, the account reserved for a second mobile computing device (Figures 6A, 6B, page 24 line 1 *et seq., inter alia.*), the account describing information that is not stored in the second mobile computing device (page 7 line 11 *et seq., inter alia.*).

The method also includes: b) modifying the account to identify an information that resides on the remote server but not on the second mobile computing device (Figures 5A, 5B, 8 and 9, page 20 line 18 *et seq., inter alia.*).

The method further includes: c) responsive to establishing a connection with the second mobile computing device, the remote server automatically determining from the account that the information is new to the second mobile computing device, and in response to the determining, automatically downloading the information to the second mobile computing device (Figures 5A, 5B, 8 and 9, page 20 line 18 *et seq., inter alia.*).

Claim 2 recites a method as described in Claim 1 further comprising the step of the remote server receiving a token identifying the information

and the second mobile computing device, and wherein the token causes the account to be modified by the remote server. This element is described at least in Figures 8 and 9 and in the Specification beginning at page 28 line 15 *et seq., inter alia.*

Claim 4 recites a method as described in Claim 1 wherein the information is a version of an application program. This element is described at least in Figures 5B, 6A, 6B, 7A and 7B and in the Specification beginning at page 6 line 7 *et seq., inter alia.*

Claim 6 recites a method as described in Claim 1 wherein the step of automatically downloading the information to the second mobile computing device, of step c), is performed only if the first mobile computing device has authority to download to the second mobile computing device. This element is described at least in Figure 8 and in the Specification beginning at page 7 line 1 *et seq., inter alia.*

Independent Claim 12 recites a system including a receiver mobile computing device (Figures 2A and 2B, page 13 line 19 *et seq., inter alia.*) and a remote server (Figure 6A, page 22 line 1 *et seq., inter alia.*) containing an account reserved (Figures 6A, 6B, page 24 line 1 *et seq., inter alia.*) for the

receiver mobile computing device which describes a complement of information stored in the receiver mobile computing device (page 7 line 11 *et seq.*, *inter alia*).

The system also includes a sender mobile computing device (Figures 2A and 2B, page 13 line 19 *et seq.*, *inter alia*.) for causing the account to be modified to identify an information that resides on the remote server but not on the receiver mobile computing device (Figures 8 and 9, page 28 line 1 *et seq.*, *inter alia*). The receiver mobile computing device is for establishing a connection with the remote server and the remote server is for automatically determining, from the account, that the information is new to the receiver mobile computing device and automatically for downloading the information to the receiver mobile computing device (Figures 5A, 5B, 8 and 9, page 20 line 18 *et seq.*, *inter alia*).

Claim 13 recites a system as described in Claim 12 wherein the sender mobile computing is for sending the remote server a token identifying both the information and the receiver mobile computing device and wherein the token causes the remote server to modify the account. This element is described at least in Figures 8 and 9 and in the Specification beginning at page 28 line 15 *et seq.*, *inter alia*.

Claim 15 recites a method as described in Claim 12 wherein the information is a version of an application program. This element is described at least in Figures 5B, 6A, 6B, 7A and 7B and in the Specification beginning at page 6 line 7 *et seq.*, *inter alia*.

Independent Claim 21 recites a system including a receiver mobile computing computer (Figures 2A and 2B, page 13 line 19 *et seq.*, *inter alia*.) and a web (Figure 1A, 1B, 6A, 6B, page 14 line 14 *et seq.*, *inter alia*.) based server (Figure 6A, page 22 line 1 *et seq.*, *inter alia*.) containing an account reserved for the receiver mobile computing computer (Figures 6A, 6B, page 24 line 1 *et seq.*, *inter alia*.) which describes a complement of information stored in the receiver mobile computing computer (page 7 line 11 *et seq.*, *inter alia*).

The sender mobile computing computer is for causing the account to be modified to identify an information that resides on the web based server but not on the receiver mobile computing compute (Figures 5A, 5B, 8 and 9, page 20 line 18 *et seq.*, *inter alia*).

The receiver mobile computing computer is for establishing a connection with the web based server and the web based server automatically determines, from the account, that the information is new to the receiver mobile computing computer, also determines if the sender mobile computing computer has

authority to download to the receiver mobile computing computer, and if so, automatically downloads the information to the receiver mobile computing computer (Figures 5A, 5B, 8 and 9, page 20 line 18 *et seq., inter alia*).

Grounds of Rejection to be Reviewed on Appeal

Appellants appeal the rejection of Claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

Arguments

A. Rejection of Claim 1 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to the combination of Multer in view of Coppinger, Appellants respectfully assert that Coppinger fails to teach any systems or methods of synchronization. Rather, Coppinger merely mentions synchronization in a single instance (Table 1) within the Specification as one possible application of a wireless network. Importantly, Coppinger fails to teach how to perform data synchronization. Accordingly, the actual teachings of Coppinger, e.g., an “account,” fail to teach or suggest anything related to synchronization. For example, Coppinger fails to teach or suggest that the taught “registration and/or authentication of wireless devices” [0029] is necessary for, or even improves synchronization.

As Coppinger fails to teach any systems or methods of synchronization, Appellants respectfully assert that any modification in view of Coppinger would be incapable of improving the synchronization teachings of the primary reference.

Accordingly, there can be no suggestion in the art to make the proposed modification. Per *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), “[A] proper analysis under § 103 requires, *inter alia*, consideration of... whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process.” Regardless of the type of disclosure, the prior art must provide some motivation or suggestion to one of ordinary skill in the art to make the claimed invention in order to support a conclusion of obviousness.

As there is no suggestion in the art that the proposed modification provides the proposed benefit, Applicants respectfully assert that the rejection relies upon impermissible hindsight to forge a combination of references guided only by the disclosure and claims of the present application.

In addition, since Coppinger fails to teach any systems or methods of synchronization, there can be no expectation of success for the proposed modification. In order to establish *prima facie* obviousness, there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully assert that there can be no expectation of success in attempting to modify a system of synchronization,

as taught by Multer, with a reference absent teachings of synchronization, as proposed by the rejection. Thus, the rejection fails to establish *prima facie* obviousness.

As the proposed modification of Multer in view of Coppinger fails to establish prima facie obviousness, Appellants respectfully assert that all rejections over Multer in view of Coppinger are overcome. Accordingly, Appellants respectfully assert that Claims 1-24 are allowable.

With respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of an “account stored on said remote server, said account reserved for a second mobile computing device” as recited by Claim 1. The rejection concedes that Multer fails to disclose this claimed limitation.

However, Multer does not merely fail to disclose this claimed limitation. Multer actually teaches away. As taught by Multer in column 17 lines 18-20, *inter alia*, an “information store is maintained on a user-by-user basis” (emphasis added). The rejection itself characterizes Multer as teaching “user accounting information for each user” (page 4 “regarding Claim 1,” emphasis added).

Appellants respectfully assert that one of ordinary skill in the art would appreciate the fundamental difference between the taught user-centric information and the recited “account reserved for a... device.” For example, a user can have multiple devices capable of synchronization, e.g., mobile phone, MP3 player, personal digital assistant, etc. As taught by Multer, information is stored on a user basis. In contrast, the instant limitation recites an account on a device basis.

Consequently, the fundamental organization and principles of operation of Multer are quite different from embodiments of the present invention that recite information storage and/or accounting on a device basis, as recited by Claim 1. Per *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001), “A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the Appellant.” As Multer teaches synchronization based on a fundamentally different accounting organization, Appellants respectfully assert that one of ordinary skill “would be led in a direction divergent from the path that was taken by the Appellant,” e.g., to user-based accounting, and hence Multer teaches away from the present claimed embodiments that recite device based accounting.

For this reason, Appellants respectfully assert that Claim 1 overcomes the rejection of record, and is thus patentable.

In addition with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “said account describing information that is not stored in said second mobile computing device” as recited by Claim 1.

Even though Multer teaches away from this claimed embodiment, the rejection introduces Coppinger. Coppinger teaches “[t]o register a wireless device, an account is created [0059, emphasis added]. Thus, the cited portion merely teaches creation of an account. Coppinger describes some information that may be posted to the account, including:

the date, the time of day, the operator's identification, a password to be used by the user of the wireless device, type and subtype of wireless device (e.g., cell phone with email capability), features of the wireless device not implicated by the model number (e.g., already installed software, memory size, etc.), the wireless address of the device (e.g., a telephone number, network node address, IP address, email address, or group address).

Coppinger fails to teach or suggest that the account “describ(es) information that is not stored in the second mobile computer device” as recited by Claim 1

In fact, the account taught by Coppinger is for a single wireless device, and has absolutely no teaching of a second wireless device.

As Coppinger fails to correct the deficiencies of Multer, nor even to teach that which is alleged by the rejection, Appellants respectfully assert that Claim 1 overcomes the rejection of record for this additional reason, and is thus patentable.

Further with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “at a remote server” as recited by Claim 1.

Coppinger fails to teach synchronization between a wireless device and a server. In Table 1 (page 3) Coppinger describes a variety of transactions between wireless device(s) in communication with a server. Notably, Coppinger fails to teach synchronization between a wireless device and a server. As Coppinger fails to teach synchronization between a wireless device and a server, Coppinger fails to support the modification proposed by the rejection. For this further reason, Appellants respectfully assert that Claim 1 overcomes the rejections of record, and is thus patentable.

Still further, Coppinger teaches wireless synchronization directly between wireless devices, bypassing a server. For example, the teachings of Coppinger teaches regarding synchronization are limited to:

Wireless device to one or more other wireless devices where exemplary wireless devices include programmable cellular telephones, PDAs, palm-top computers, pagers, and programmable radio frequency identification (RFD) devices. (Table 1)

Thus, in teaching direct wireless to wireless synchronization, Coppinger actually teaches away from embodiments in accordance with the present invention that recite synchronization at a server, and Multer, that recite server-based synchronization. Per *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001), “A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the Appellant.”

Appellants respectfully assert that in consideration of Coppinger’s teachings of direct wireless to wireless synchronization, one of ordinary skill in the art would be taught away from the claimed embodiments in accordance with the present invention that recite server based synchronization, for example as recited in Claim 1.

For this still further reason, Appellants respectfully assert that Claim 1 overcomes the rejections of record, is thus patentable.

Still yet further with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “modifying said account to identify an information that resides on said remote server but not on said second mobile computing device” as recited by Claim 1.

In contrast, Multer teaches, “the storage server will be checked to determine whether a new version of the data exists on the storage server (column 34, lines 24-26). In other words, Multer teaches determining the possible existence of new information as a part of the synchronization process. By teaching determining the existence of new information is a part of the synchronization process, Multer teaches a totally different and differentiated method from the recited storage of information “not stored in said second mobile computing device” as recited by Claim 1. Coppinger is not alleged to correct this deficiency of Multer, and it does not.

For this still yet further reason, Appellants respectfully assert that Claim 1 overcomes the rejections of record, is thus patentable.

Further yet still with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “describing information that is not stored in said second mobile computing device” as recited by Claim 1. As recited, embodiments of the present invention in accordance with Claim 1 describe information that is not stored in said second mobile computing device. In contrast, Multer teaches storage of “a user’s entire file system tree” (column 33, line 4, emphasis added, *inter alia*). By teaching storage of all of a user’s data, including data that may be stored on the remote device, Multer actually teaches in direct opposition to the recited limitation of storing a “information that is not stored in said second mobile computing device” as recited by Claim 1.

For this further yet still reason, Appellants respectfully assert that Claim 1 overcomes the rejection of record, and is thus patentable.

In addition with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “modifying said account to identify an information that resides on said remote server but not on said second mobile computing device” as recited by Claim 1. For example, Multer teaches, “(after a device connects) the storage server will be checked to determine whether a new version of the data exists on the storage server” (column 34 lines 23-26, emphasis added). Thus, in

contrast to the recited limitation of Claim 1, the system of Multer does not know whether information resides on a device until the device connects to the server. Thus, Multer does not teach or suggest modifying an account to identify information “not stored in said second mobile computing device” as recited by Claim 1. Coppinger is not alleged to correct this deficiency of Multer, and it does not.

For this additional reason, Appellants respectfully assert that Claim 1 overcomes the rejection of record, and is thus patentable.

Further still with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “describing information that is not stored in said second mobile computing device” as recited by Claim 1. As described previously, and as recognized by the rejection, Multer operates on a user basis. Consequently, Multer fails to teach or suggest the recited device of the instant limitation. Coppinger is not alleged to correct this deficiency of Multer, and it does not.

For this further reason, Appellants respectfully assert that Claim 1 overcomes the rejection of record, and is thus patentable.

Still yet further with respect to Claim 1, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of:

said remote server automatically determining from said account that said information is new to said second mobile computing device, and in response to said determining, automatically downloading said information to said second mobile computing device

as recited by Claim 1. In contrast, Multer teaches a conventional synchronization in which device data is compared to a user's complete data set to determine any new information. Consequently, Multer teaches determining that information is new based upon interaction with the (second) device, in contrast to the recited "determining from said account."

Coppinger is not alleged to correct this deficiency of Multer, and it does not. For this still yet further reason, Appellants respectfully assert that Claim 1 overcomes the rejection of record, and is thus patentable.

In summary, while Multer in view of Coppinger may teach some form of synchronization, the combination of cited references fails to teach or suggest any of the claimed limitations as recited by Claim 1, and in many instances actually teach away from such limitations.

Accordingly, the rejections of record are overcome, *prima facie* obviousness has not been established, and thus Claim 1 is patentable.

B. Rejection of Claims 2-11 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

Claims 2-11 depend from Claim 1. Appellants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and are thus patentable.

C. Rejection of Claim 2 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to Claim 2, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “said remote server receiving a token identifying said information and said second mobile computing device, and wherein said token causes said account to be modified by said remote server” as recited by Claim 2. Coppinger is not alleged to teach or suggest this element, and it does not. Appellants respectfully assert that Multer does not even utilize the word “token” or similar terms.

Appellants appreciate that identity of terminology is not required. However, Appellants respectfully assert that the rejection improperly equates Multer’s taught “datapack” with the recited token. Multer teaches that a datapack is “a compacted and encrypted Change Log” (column 16 line 43). For example, at taught by the reference, a datapack records, or “logs” changes. Appellants respectfully assert that one of ordinary skill in the art would understand a fundamental difference between the recited “token” and the taught “change log.” Moreover, Multer fails to teach any action caused by

the datapack, in contrast to the claimed limitation “wherein said token causes” as recited by Claim 2.

For this additional reason, Appellants respectfully assert that Claim 2 overcomes the rejection of record, and is thus patentable.

Further with respect to Claim 2, the rejection asserts that Multer column 37, lines 62-65 teaches the recited “token.” Appellants respectfully traverse. The cited portion of Multer teaches, “[a] DataPack essentially contains a sequence of transactions describing changes to information.” Appellants respectfully assert that this cited teaching as well as the whole of Multer fails to teach or suggest the recited token that identifies said second mobile computing device and causes said account to be modified, as recited by Claim 2. Multer is completely silent as to these recited attributes of a token.

Coppinger is not alleged to correct this deficiency of Multer, and it does not. For this further reason, Appellants respectfully assert that Claim 2 overcomes the rejection of record, and is thus patentable.

D. Rejection of Claim 4 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to Claim 4, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “wherein said information is a version of an application program” as recited by Claim 4. Appellants respectfully assert that Multer is silent as to synchronization of application programs. Appellants respectfully assert that the rejection improperly equates Multer’s “versioning module” with the recited “application program.” Multer teaches, “a versioning module... applies a version number per object in the data package” (column 12 lines 10-12). For example, as taught by Multer, a “version number” is applied to non-executable data objects, e.g., a telephone number. Appellants respectfully assert that the taught applying a version number fails to teach or suggest the recited “application program” to one of ordinary skill in the art.

Coppinger is not alleged to correct this deficiency of Multer, and it does not. For this additional reason, Appellants respectfully assert that Claim 4 overcomes the rejection of record, and is thus patentable.

E. Rejection of Claim 6 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to Claim 6, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “said step of automatically downloading said information to said second mobile computing device, of step c), is performed only if said first mobile computing device has authority to download to said second mobile computing device” as recited by Claim 6.

Appellants respectfully assert that Multer in view of Coppinger are silent as to restricting download based on such authority. For example, as previously presented with respect to Claim 1, Coppinger teaches an account for a single wireless device, and has absolutely nothing to do with a second wireless device. As taught by Multer, information is stored on a user basis. Neither reference has need for, or teaches methods or apparatus for establishing or maintaining information related to “authority to download to said second mobile computing device” as recited by Claim 6.

For this additional reason, Appellants respectfully assert that Claim 6 overcomes the rejection of record, and is thus patentable.

F. Rejection of independent Claim 12 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

Appellants respectfully assert that Claim 12 overcomes the rejections of record for at least the rationale previously presented with respect to Claim

1. For example, Multer teaches an “information store is maintained on a user-by-user basis.” Thus, Multer teaches away from the claimed limitations of “an account reserved for said receiver mobile computing device” as recited by Claim 12. For at least all of these reasons, Claim 12 is patentable.

In addition, Claims 12 recites, in part,

a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in said receiver mobile computing device.

The contextual meaning of “complement” is set forth in the Specification at page 7 line 11 *et seq.*, *inter alia*, as “information that resides on the remote server but not on the receiver handheld device.” Thus Claim 12 does not recite a mere number or amount of information, but rather the set-theory meaning of complement, e.g., the set of elements of a set that are not in a

given subset. For example, as recited, the remote server describes a set of information that is not stored in the receiver mobile computing device.

Appellants respectfully assert that Multer teaches away from the claim limitation of “an account ...which describes a complement of information stored in said receiver mobile computing device” as recited by Claim 12. As recited, embodiments of the present invention in accordance with Claim 12 describe information that is not stored in said mobile computer device. In contrast, Multer teaches storage of “a user’s entire file system tree” (column 33, line 4, *inter alia*). By teaching storage of all of a user’s data, including data that may be stored on the remote device, Multer actually teaches away from the recited limitation of storing a “complement of information stored in said receiver mobile computing device” as recited by Claim 12.

The teaching of storing an entire file system is relevant as Multer teaches away from the limitation of “an account ...which describes a complement of information stored in said receiver mobile computing device” as recited by Claim 12. As is known by those of skill in the art, the recited complement of information stored refers to a limited portion of the total information, e.g., that information that is not stored in the second device. From set theory, a complement is the set of all elements in the set that are

not in a specified subset. Moreover, the recited complement of information specifically excludes the information already stored.

In contrast, Multer teaches storing all of the information. Storing all of the information is fundamentally different from storing a portion of the information and excluding another portion of the information. In teaching storing all of the information, Multer actually teaches away from embodiments in accordance with the present invention that recite not storing all of the information, as recited by Claim 12.

For this additional reason, Appellants respectfully assert that Claim 12 overcomes the rejection of record, and is thus patentable.

Further with respect to Claim 12, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “a sender mobile computing device for causing said account to be modified to identify an information that resides on said remote server but not on said receiver mobile computing device” as recited by Claim 12.

As previously presented with respect to Claims 1 and 12, Multer in view of Coppinger is silent as to this claimed limitation. Moreover, Multer teaches away from both device based accounts and “information that resides

on said remote server but not on said receiver mobile computing device” as recited by Claim 12. For example, Multer teaches user based accounts and storing all information on the server.

For this further reason, Appellants respectfully assert that Claim 12 overcomes the rejection of record, and is thus patentable.

G. Rejection of Claims 13-20 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

Claims 13-20 depend from Claim 12. Appellants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and are thus patentable.

H. Rejection of Claim 13 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to Claim 13, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “a token identifying both said information and said receiver mobile computing device and wherein said token causes said remote server to modify said account” as recited by Claim 13. Coppinger is not alleged to teach or suggest this element, and it does not. Appellants respectfully assert that Multer does not even utilize the word “token” or similar terms.

Appellants appreciate that identity of terminology is not required. However, Appellants respectfully assert that the rejection improperly equates Multer’s taught “datapack” with the recited token. Multer teaches that a datapack is “a compacted and encrypted Change Log” (column 16 line 43). For example, at taught by the reference, a datapack records, or “logs” changes. Appellants respectfully assert that one of ordinary skill in the art would understand a fundamental difference between the recited “token” and the taught “change log.” Moreover, Multer fails to teach any action caused by the datapack, in contrast to the claimed limitation “wherein said token causes” as recited by Claim 13.

For this additional reason, Appellants respectfully assert that Claim 13 overcomes the rejection of record, and is thus patentable.

Further with respect to Claim 13, the rejection asserts that Multer column 37, lines 613-65 teaches the recited “token.” Appellants respectfully traverse. The cited portion of Multer teaches, “[a] DataPack essentially contains a sequence of transactions describing changes to information.” Appellants respectfully assert that this cited teaching as well as the whole of Multer fails to teach or suggest the recited token that identifies both said information and said receiver mobile computing device and wherein said token causes said remote server to modify said account, as recited by Claim 13. Multer is completely silent as to these recited attributes of a token.

Coppinger is not alleged to correct this deficiency of Multer, and it does not. For this further reason, Appellants respectfully assert that Claim 13 overcomes the rejection of record, and is thus patentable.

I. Rejection of Claim 15 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

With respect to Claim 15, Appellants respectfully assert that Multer in view of Coppinger fails to teach or suggest the claimed limitations of “wherein said information is a version of an application program” as recited by Claim 15. Appellants respectfully assert that Multer is silent as to synchronization of application programs. Appellants respectfully assert that the rejection improperly equates Multer’s “versioning module” with the recited “application program.” Multer teaches, “a versioning module... applies a version number per object in the data package” (column 12 lines 10-12). For example, as taught by Multer, a “version number” is applied to non-executable data objects, e.g., a telephone number. Appellants respectfully assert that the taught applying a version number fails to teach or suggest the recited “application program” to one of ordinary skill in the art.

Coppinger is not alleged to correct this deficiency of Multer, and it does not. For this additional reason, Appellants respectfully assert that Claim 15 overcomes the rejection of record, and is thus patentable.

J. Rejection of Claims 21-24 under 35 U.S.C. § 103(a) over Multer et al. (US# 6,757,696 B2, “Multer”) in view of Coppinger et al. (US 2001/0046862, “Coppinger”).

Appellants respectfully assert that Claim 21 overcomes the rejections of record for at least the rationale previously presented with respect to Claim 1, and is thus patentable.

Claims 22-24 depend from Claim 21. Appellants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and are thus patentable.

Comments in Reply to Examiner's Answer

In the "Response to Argument" section at A1, the Examiner's Answer argues that "Multer discloses accounting information based on an individual user." The Examiner's Answer further expands on one of the differences between the taught "based on an individual user" and the recited "account reserved for a... device." For example, the Examiner's Answer states, "a particular user can have multiple devices...." Since a particular user can have multiple devices, Multer's user-based accounting is incapable of differentiating among such multiple devices, for example, if one device is not supposed to update another device, or a particular device is not intended to store certain types of information, while other of a user's devices may store such information.

As Multer is the primary reference, the rejection proposes to change this fundamental principle of operation, e.g., user-based accounting, in favor of the recited "account reserved for a... device." Per *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."

Appellants respectfully assert that the proposed modification is not taught by the references, and in fact is improper per *In re Ratti*.

Further, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The modification proposed by the rejection changes the accounting system of Multer from a user-based accounting, as taught, to an “account reserved for a... device.” Thus, the proposed modification renders the primary reference unsatisfactory for its intended purpose of user-based accounting and organization. Accordingly, the proposed modification is improper per *In re Gordon*.

In the “Response to Argument” section at A2, the Examiner’s Answer argues that Multer does not teach away from Coppinger: “To teach away, a reference must criticize or discourage a particular embodiment of an invention...” Appellants traverse. Applicants understand the criteria for “teaching away” to be set forth in the previously referenced *In re Haruna* decision of the Federal Circuit. Appellants respectfully assert that one of ordinary skill “would be led in a direction divergent from the path that was taken by the Appellant,” e.g., to user-based accounting as taught by Multer, and away from the recited “account reserved for a... device.”

Accordingly, as the references teach away, the rejection fails to establish prima facie obviousness.

In the “Response to Argument” section at A3, the Examiner’s Answer argues that “Coppinger discloses a complement of information within the account.” Appellants are confused by this statement, as the term “complement” does not appear in Claim 1. However, the taught creation of an account and the taught exemplary list of account information in Coppinger fails to teach or suggest the claimed limitations of “said account describing information that is not stored in said second mobile computing device” as recited by Claim 1.

In the “Response to Argument” section at A4, the Examiner’s Answer states that Multer, not Coppinger, is used to reject the claimed limitations of “said account describing information that is not stored in said second mobile computing device” as recited by Claim 1.

However, as repeatedly conceded by the rejection, Multer is organized on a user basis. Thus, while Multer may perform synchronization, Multer does not teach that the user account describes “information that is not stored in said second mobile computing device” as recited by Claim 1.

In contrast, Multer teaches, “the storage server will be checked to determine whether a new version of the data exists on the storage server (column 34, lines 24-26). In other words, Multer teaches determining the possible existence of new information as a part of the synchronization process. By teaching determining the existence of new information is a part of the synchronization process, Multer teaches that the user account does not describe “information that is not stored in said second mobile computing device” as recited by Claim 1. For example, if Multer’s account already described “information that is not stored in said second mobile computing device,” there would be no need to perform the taught “checking” operations.

Accordingly, Multer teaches a totally different and differentiated method from the recited storage of information “not stored in said second mobile computing device” as recited by Claim 1.

In the “Response to Argument” section at A5, the Examiner’s Answer cites Coppinger Table 1. As previously presented, Table 1 describes a variety of transactions between wireless device(s) in communication with a server. Notably, Coppinger fails to teach synchronization between a wireless device and a server.

In this same response section, the Examiner's Answer cites Coppinger paragraph [0030] to teach that a "wireless device may act as both a 'client' and 'server.'" This argument is not germane, as Coppinger fails to teach synchronization between a wireless device and a server. For example, there is no teaching of synchronization between wireless devices in which one is acting as a "server."

In the "Response to Argument" section at A6, the Examiner's Answer sets forth an interpretation of Claim 1 that "a connection is completed between two computer devices before a determination of information status is completed." Appellants traverse this interpretation.

Claim 1 recites a "remote server" and first and second "mobile computing devices." Limitation a) of Claim 1 recites:

accessing an account stored on said remote server, said account reserved for a second mobile computing device, said account describing information that is not stored in said second mobile computing device

The recited "accessing" is further "responsive to receiving a signal from a first mobile computing device."

Claim 1 does not recite a connection between the first and second mobile computing devices.

In the “Response to Argument” section at C1, the Examiner’s Answer repeats the above-cited argument citing to Multer column 37, lines 62-65. Appellants reiterate that the taught “DataPack” describes information after the fact, as previously presented. Further, neither the rejection nor the Examiner’s Answer identify a portion of the cited reference wherein the DataPack is alleged to “cause() said account to be modified by said remote server” as recited by Claim 2.

In the “Response to Argument” section at D1, the Examiner’s Answer argues that “each application is also an object.” However, since Multer teaches a version number per object, each application, even the of the same release level, would have a different version number under the Answer’s interpretation. Thus, while Multer may teach a “version number,” this teaching does not suggest “a version of an application program (automatically downloaded to said second mobile computing device)” as recited.

The Examiner’s Answer further introduces arguments based on Coppinger. For example, the Answer cites Coppinger paragraph [0047]. While this paragraph may teach something related to an application program

may be “installed” in a wireless device, this cited paragraph and the whole of Coppinger fails to teach that such installation is wireless, or that such installation is part of a synchronization process. It is well known to install software via non-synchronization processes, for example, via a read-only install media, e.g., CD-ROM.

The Answer also cites to Coppinger paragraph [0056]. While this paragraph may teach something about software version control, this cited paragraph and the whole of Coppinger fails to teach downloading “a version of an application program” as recited by Claim 4. For example, Coppinger teaches, “[a] method for registering a particular wireless device may include any steps of recording information about the particular wireless device and its permitted uses.” Accordingly, Coppinger is consistent with merely checking a software version to determine if its use is permitted. Such “checking for permission” fails to teach or suggest the instant claimed limitations.

The Answer further cites to Coppinger paragraph [0075]. While this paragraph may teach something about a version of an application program, this cited paragraph and the whole of Coppinger fails to teach or suggest downloading “a version of an application program” as recited by Claim 4. For example, Coppinger teaches, “those already having a particular APW or

DAPW of a specified name, version or having been activated during a specified period of time, etc.” (emphasis added). Thus, in contrast to the instant claimed limitations of downloading “a version of an application program,” Coppinger teaches identifying version numbers of application programs already installed. Notably, this paragraph and the whole of Coppinger fails to teach or suggest downloading “a version of an application program” as recited by Claim 4.

In the “Response to Argument” section at E1, the Examiner’s Answer cites Multer column 3 lines 46-50:

The controller includes an authentication module specifically associating the user data with a particular user, identifying the user agent as associated with a user having access to the user data, and controlling operations on the user data by the user agent. (emphasis added)

This cited portion and the whole of Multer teach user-based organization. The recited “authority” is device based, e.g., the first device has authority to download to the second device. For example, one user may “forbid” a particular one of his devices from updating a particular second device, in accordance with embodiments of the present invention. Multer’s user-based authentication cannot support such a scenario, as it does not differentiate

between devices belonging to the same user. Accordingly, Multer cannot teach or suggest the claimed limitations of “said step of automatically downloading said information to said second mobile computing device, of step c), is performed only if said first mobile computing device has authority to download to said second mobile computing device” as recited by Claim 6.

Conclusions

Appellants believe that pending Claims 1-24 are patentable over the cited art. Appellants respectfully request that the rejection of these claims be reversed.

Respectfully submitted,

MURABITO, HAO & BARNES LLP

Date: 12-02-09

/Anthony C. Murabito/
Anthony C. Murabito
Reg. No. 35,295

Two North Market Street
Third Floor
San Jose, California 95113
(408) 938-9060

Claims Appendix

1. (previously presented) A method of transferring information comprising the steps of:

a) at a remote server, responsive to receiving a signal from a first mobile computing device, accessing an account stored on said remote server, said account reserved for a second mobile computing device, said account describing information that is not stored in said second mobile computing device;

b) modifying said account to identify an information that resides on said remote server but not on said second mobile computing device;

c) responsive to establishing a connection with said second mobile computing device, said remote server automatically determining from said account that said information is new to said second mobile computing device, and in response to said determining, automatically downloading said information to said second mobile computing device.

2. (previously presented) A method as described in Claim 1 further comprising the step of said remote server receiving a token identifying said information and said second mobile computing device, and wherein said token causes said account to be modified by said remote server.

3. (previously presented) A method as described in Claim 1 wherein said first and said second mobile computing devices are portable electronic computer systems.

4. (original) A method as described in Claim 1 wherein said information is a version of an application program.

5. (previously presented) A method as described in Claim 4 wherein said account comprises an application version record table comprising an entry for each application stored in said second mobile computing device and wherein each entry comprises: an application identifier; a version identifier; and a user identifier.

6. (previously presented) A method as described in Claim 1 wherein said step of automatically downloading said information to said second mobile computing device, of step c), is performed only if said first mobile computing device has authority to download to said second mobile computing device.

7. (previously presented) A method as described in Claim 6 wherein said authority is established via an express grant of permission from said second mobile computing device to said first mobile computing device.

8. (previously presented) A method as described in Claim 6 wherein said authority is established via a user confirmation that is made in response to a user message displayed on a display screen of said second mobile computing device.

9. (original) A method as described in Claim 1 wherein said remote server is a web based server.

10. (previously presented) A method as described in Claim 1 wherein said step d) is performed within a synchronization process between said remote server and said second mobile computing device.

11. (previously presented) A method as described in Claim 1 wherein said step d) is performed within a synchronization process between a host computer system and said second mobile computing device.

12. (previously presented) A system comprising:
a receiver mobile computing device;
a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in said receiver mobile computing device;

a sender mobile computing device for causing said account to be modified to identify an information that resides on said remote server but not on said receiver mobile computing device;

wherein said receiver mobile computing device is for establishing a connection with said remote server; and

wherein said remote server is for automatically determining, from said account, that said information is new to said receiver mobile computing device and automatically for downloading said information to said receiver mobile computing device.

13. (previously presented) A system as described in Claim 12 wherein said sender mobile computing is for sending said remote server a token identifying both said information and said receiver mobile computing device and wherein said token causes said remote server to modify said account.

14. (previously presented) A system as described in Claim 12 wherein said sender and said receiver mobile computing devices are mobile computing computer systems.

15. (original) A system as described in Claim 12 wherein said information is a version of an application program.

16. (previously presented) A system as described in Claim 15 wherein said account comprises an application version record table comprising an entry for each application stored in said receiver mobile computing device and wherein each entry comprises: an application identifier; a version identifier; and a user identifier.

17. (previously presented) A system as described in Claim 12 wherein said remote server is also for determining if said sender mobile computing device has authority to download to said receiver mobile computing device as a precursor to downloading said information to said receiver mobile computing device.

18. (previously presented) A system as described in Claim 17 wherein said authority is established via an express grant of permission from said receiver to said sender mobile computing device.

19. (previously presented) A system as described in Claim 17 wherein said authority is established via a user confirmation that is made in response to a user message displayed on a display screen of said receiver mobile computing device.

20. (original) A system as described in Claim 12 wherein said remote server is a web based server.

21. (previously presented) A system comprising:

- a receiver mobile computing computer;
- a web based server containing an account reserved for said receiver mobile computing computer which describes a complement of information stored in said receiver mobile computing computer;
- a sender mobile computing computer for causing said account to be modified to identify an information that resides on said web based server but not on said receiver mobile computing computer;
- wherein said receiver mobile computing computer is for establishing a connection with said web based server; and
- wherein said web based server automatically determines, from said account, that said information is new to said receiver mobile computing computer, also determines if said sender mobile computing computer has authority to download to said receiver mobile computing computer, and if so, automatically downloads said information to said receiver mobile computing computer.

22. (previously presented) A system as described in Claim 21 wherein said sender mobile computing is for sending said remote server a token

identifying both said information and said receiver mobile computing and wherein said token causes said web based server to modify said account.

23. (original) A system as described in Claim 21 wherein said information is a version of an application program.

24. (previously presented) A system as described in Claim 21 wherein said account comprises an application version record table comprising an entry for each application stored in said receiver mobile computing computer and wherein each entry comprises: an application identifier; a version identifier; and a user identifier.

Evidence Appendix

None.

Related Proceedings Appendix

None.